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(ii) heating both of the outermost latex surface layers of the recording medium to provide transparent films.

11. (New) A curl-controlling method according to claim 10, wherein pressure is applied to the recording medium at the same time as heating in step (ii).--

REMARKS

Favorable reconsideration and allowance of the subject application are respectfully solicited.

Status of the Claims

Claims 1-11 are currently under consideration in this application, with Claims 1 and 9 being independent. Claims 4, 5 and 7-9 are withdrawn from consideration. Claims 1 and 9 have been amended to recite that a layer primarily comprises latex resin. Support can be found in the specification at least at page 8, lines 8-13. Claims 10 and 11 are newly added. Support can be found in the specification at least at page 5, lines 5-13. It is submitted that no new matter has been added by the amendments herein.

Restriction Requirement

The Examiner has made a restriction requirement between Group I (Claims 1-3 and 6, drawn to a recording medium)

and Group II (Claims 7-9, drawn to a print). Claims 1-3 and 6 were considered to be constructively elected and Claims 7-9 were withdrawn from consideration. Applicant respectfully traverses the restriction requirement.

It is respectfully submitted that all of the claims could be searched by one Examiner without undue effort. It is also respectfully submitted that it is not mandatory to make a restriction requirement in every possible situation.

It is believed that if one Examiner acts on all of the claims of the present application at one time, overall examining time will be less than if two or more Examiners are involved. It is also earnestly believed that the examination of all of the claims at one time by one examiner in the present application will best ensure uniform prosecution quality. Therefore, in the interest of prosecution economy of time and quality for both the Office and Applicant, it is respectfully submitted that withdrawal of this Restriction Requirement and examination of all pending claims on their merits are appropriate and such action is respectfully solicited.

Rejection Under Section 103

Claims 1-3 and 6 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over Hirose et al. (U.S. Patent No. 6,203,899), taken alone or in view of either of Malhotra (U.S. Patent No. 6,180,238) or Cousin et al. (U.S. Patent No.

4,554,181). Applicant respectfully disagrees with these rejections.

Before addressing the merits of the rejection, Applicant believes it will be helpful to review some features of the present invention. As recited in Claim 1, the present invention relates to a recording medium comprising a substrate having two surfaces, on both of which are provided an ink-receiving layer containing an inorganic pigment, and an outermost surface layer primarily comprising thermoplastic latex resin, in this order. The outermost latex surface layer forms a transparent film upon heating of the recording medium. Claim 9 relates to a print having similar features.

In Applicant's view, the cited references do not teach or suggest the claimed invention. The Examiner takes the position that the outermost surface layer of Hirose et al. would inherently be transparent. Applicant respectfully submits that the outermost surface layer of Hirose et al. does not inherently form a transparent film upon heating of the recording medium, and that this feature would not be obvious in view of the cited references.

To establish inherency, the missing feature must necessarily be present in the reference. MPEP 2112. In the present invention, the outermost surface layer of the substrate is principally formed from a thermoplastic latex resin (see page 8, lines 8-13). In contrast, the surface layer disclosed in

Hirose et al. is composed principally of cationic ultrafine particles such as oxides of metals or silica, and may optionally contain a binder resin and other additive components (col. 3, line 62 to col. 4, line 3; col. 4, lines 40-43). Because the presence of a binder resin in the surface layer of Hirose et al. is merely optional, there is no basis to conclude that the surface layer of Hirose et al. would inherently form a transparent film upon heating of the recording medium. Furthermore, even assuming that the surface layer of Hirose et al. includes a binder resin, the principal component of the surface layer would still be ultrafine particles. Because of this key difference in composition, Applicant concludes that it cannot be said that the surface layer of Hirose et al. would inherently behave like the outermost layer of the claimed invention and form a transparent film upon heating of the recording medium. Accordingly, Hirose et al. does not render the present invention obvious.

The secondary references Malhotra et al. and Cousin et al. mention that the recording sheet may be coated on both sides. However, like Hirose et al., neither of these references teaches or suggests an outermost surface layer that forms a transparent film upon heating of the recording medium. Accordingly, they do not remedy the deficiencies of Hirose et al.


Applicant submits that the present invention is patentably defined by independent Claims 1 and 9. The dependent

claims are allowable for the reasons given with respect to Claim 1, and because they recite features which are patentable in their own right. Individual consideration of the dependent claims is respectfully solicited.

In view of the above amendments and remarks, the claims are now in allowable form. Therefore, rejoinder of withdrawn Claims 4, 5 and 7-9 and early passage to issue are respectfully solicited.

Applicant's undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,



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VERSION WITH MARKINGS TO SHOW CHANGES MADE TO CLAIMS

1. (Four Times Amended) A recording medium
comprising:

a substrate having two surfaces, on both of which are
provided an ink receiving layer containing an inorganic pigment
and an outermost surface layer primarily comprising [containing
a] thermoplastic latex resin, in this order,

wherein the outermost latex surface layer forms a
transparent film upon heating of the recording medium.

9. (Amended) A print comprising:

a substrate having two surfaces, on both of which are
provided an ink receiving layer containing an inorganic pigment
and a layer primarily comprising latex resin, in this order,

wherein an image is formed on at least one of the ink
receiving layers, and

wherein the layer comprising latex resin forms a
transparent film upon heating of said print.